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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,399	09/24/2001	Hiroshi Hashimoto	011225	5652
23850	7590	07/22/2004	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP			WEISS, HOWARD	
1725 K STREET, NW			ART UNIT	PAPER NUMBER
SUITE 1000				2814
WASHINGTON, DC 20006				

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/960,399	HASHIMOTO ET AL.
	Examiner	Art Unit
	Howard Weiss	2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 May 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-16 and 18 is/are pending in the application.
 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 16 and 18 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 1-16 and 18 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 20 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

Attorney's Docket Number: 011225

Filing Date: 9/24/01

Continuing Data: RCE established 3/5/03 and 5/18/04

Claimed Foreign Priority Date: 6/21/01 (JPX)

Applicant(s): Hashimoto et al. (Takahashi)

Examiner: Howard Weiss

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/18/04 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims state that the total thickness of the first and second silicon films be substantially equal to the total thickness of the third and second silicon films. This implies that the thicknesses of the first and third silicon films should be substantially equal. There is no support for this limitation in the Specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Initially, and with respect to Claims 16 and 18, note that a "product by process" claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and the related case law cited therein which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. As stated in Thorpe,

even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir. 1935).

Note that Applicant has burden of proof in such cases as the above case law makes clear.

6. Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted Prior Art Figures 8 and Gwen et al. (U.S. Patent No. 5,472,892).

Admitted Prior Art Figures 8 shows most aspects of the instant invention including:

- a substrate **11** with a non-volatile memory **A** including a floating gate **13** with a control gate **16** formed on said floating gate via an insulation film **14**
- first to third MOS transistors **B**, **C**, **D** with gates insulation films **12B**, **12C**, **12D** of increasing thicknesses and gate electrodes **16B**, **16C**, **16D** of substantially identical height.

Admitted Prior Art Figures 8 do not show the control and MOS gates constructed of two silicon films with the total thickness silicon films of the gate electrodes being the same. Gwen et al. teach (e.g. Figure 3I) to form control gate (in cell array region) and MOS gates (in peripheral circuit region) of two silicon films **206**, **208** stacked upon each other and of substantially the same thickness to decrease the number of processing steps (Column 4 Lines 45 to 50) and for the gate electrodes of storage cell transistors and transistors in a peripheral circuit region to have the same height (Column 2 Lines 49 to 55). It would have been obvious to a person of ordinary skill in the art at the time of invention to form control and MOS gates of two silicon films stacked upon each other as taught by Gwen et al. in the device of the Admitted Prior Art Figures 8 to decrease the number of processing steps and for the gate electrodes of storage cell transistors and transistors in a peripheral circuit region to have the same height.

As to the grounds of rejection under "product by process", how the gate electrodes are formed (either from the same silicon films or from different films) or in what order each layer is deposited relates to intermediate process steps and does not affect the final device structure. See MPEP § 2113 which discusses the handling of "product by process" claims.

Response to Arguments

7. The Applicants' arguments filed 7/31/03 have been fully considered but they are not persuasive. The language of amended Claim 16 recites that the total thickness of the first and second silicon films be substantially equal to the total thickness of the third and second silicon films. This implies that the thicknesses of the first and third silicon films should be substantially equal. Firstly, the Examiner requests that the Applicants indicate where in the specification this limitation (i.e. that the first and third silicon films be equal in thickness) is described. Secondly, this limitation would imply that the floating gate (i.e. third silicon film) and one of the silicon films in the peripheral transistors be substantially equal. Gwen et al. show that the silicon films **204** (floating gate) and **206** to be substantially equal in thickness. Lastly, Gwen et al. state that one of the purposes of their invention is for the gate electrodes (both in storage cells and in peripheral transistors) to be of the same height (Column 2 Lines 49 to 55). In view of these reasons and those set forth in the present office action, the rejections of the stated claims stand.

Conclusion

8. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(703) 872-9306**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Weiss at **(571) 272-1720** and between the hours of 8:00 AM to 4:00 PM (Eastern Standard Time) Monday through Friday or by e-mail via **Howard.Weiss@uspto.gov**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 2800 Receptionist at **(703) 308-0956**.

10. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 257/321,392	thru 7/16/04
Other Documentation: none	
Electronic Database(s): EAST	thru 7/16/04

HW/hw
16 July 2004

Howard Weiss
Examiner
Art Unit 2814

